

U.S. Application No. 10/651,428, filed August 29, 2003
Attorney Docket No. 17405US04
Response AF dated February 19, 2009 to Provoke Advisory Action
In Response to Office Action Made Final mailed December 19, 2008

REMARKS

Claims 1-7, 9 and 13-20 are pending in the present application. Claims 1-7, 9 and 13-20 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,069,648 (“Suso”) in view of U.S. Patent No. 6,718,298 B1 (“Judge”) and further in view of Japan Patent Document No. JP 362167645 A (“Ise”). Applicant respectfully traverses the rejection for at least the reasons as set forth below.

Claim 1 recites, in part, “recording a set of data frames according to the chosen recording mode, the recorded set of data frames comprising a downlink voice signal, a downlink video signal, an uplink voice signal and an uplink video signal in which the downlink video signal is recorded at the mobile set when the downlink voice signal is determined to have voice activity and in which the uplink video signal is recorded at the mobile set when the uplink voice signal is determined to have voice activity”.

None of the cited documents teaches that the recorded set of data frames comprises a downlink voice signal, a downlink video signal, an uplink voice signal and an uplink video signal.

The Office Action Made Final at page 2 alleges that this is taught in Suso at FIG. 8(b) and col. 7, lines 10-35. Suso at FIG. 8(b) merely shows a self-image 25a and an image 25b from the other side. In each case, it is merely a photograph. There is no *video* signal illustrated and, in particular, there is no *uplink video* signal or *downlink video* signal illustrated. Suso at col. 7, lines 10-35 again merely describe self-image 25a and image 25b from the other side. Suso at col. 7, lines 10-35 also describes the other-side/self button 25c which merely switches display modes between (1) self-image and other image; (2) only self-image; (3) only other image. Again, there is no *video* signal described and, in particular, no *uplink video* signal or *downlink video* signal described.

Neither Judge nor Ise, as alleged, make up for the teaching deficiencies of Suso, as alleged. Therefore, the obviousness rejection cannot be maintained.

In addition, M.P.E.P. § 2143.01(VI) states that “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention

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being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.”

It is respectfully submitted that FIG. 6 of Suso illustrates the principle of operation of the invention in Suso. The attention of the Examiner is respectfully directed to Suso at col. 4, line 63 to col. 5, line 15, which describes that cursor button 15 sequentially moves cursor 17 from choice 1 to choice 2 to choice 3. Once the cursor is on one of the choices, the determination button 16 selects the one and only one choice.

Thus, it is clear from the description in Suso and FIG. 6 of Suso that the invention in Suso, namely, an information communication terminal device can only be operating in one and only one mode at a time. In other words, without changing the principle operation of the invention in Suso, the information communication terminal device in Suso cannot record in “recording mode” and be in the middle of a telephone conversation in “transmission/reception mode”.

Thus, the proposed modification of Suso in view of the other cited documents cannot be maintained since the proposed modification would “change the principle of operation of the prior art invention being modified”. M.P.E.P. § 2143.01(VI).

M.P.E.P. § 2143.01(VI) concludes that, if the proposed modification of Suso would change the principle of operation of the Suso invention being modified, then the teachings of Suso, Judge and Ise are not sufficient to render the claims *prima facie* obvious.

For at least the reasons as set forth below, it is believed that a *prima facie* case of obviousness has not been presented with respect to independent claim 1 and its rejected dependent claims 2, 7-9, 12 and 13.

The same or similar arguments that were made with respect to independent claim 1 are made, if applicable, with respect to independent claims 3 and 4.

For at least the reasons as set forth below, it is believed that a *prima facie* case of obviousness has not been presented with respect to independent claims 3 and 4 and their rejected dependent claims 5, 6, 10, 11 and 14-20.

With respect to claim 13, 15, 17 and any other claims that were similarly rejected, Applicant respectfully challenges each and every taking of Official Notice and/or the conclusory

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assertions of what is allegedly well known in the Office Action without providing any supporting documentary evidence.

Applicant respectfully challenges the taking of Official Notice and/or the conclusory assertions of what is allegedly well known in the Office Action Made Final, without providing any supporting documentary evidence, as being improper under normal Final Rejection practice.

The Manual of Patent Examining Procedure (“M.P.E.P.”) cautions that “[w]hile ‘official notice’ may be relied on, these circumstances should be *rare* when an application is under final rejection or action under 35 CFR 1.113”. See M.P.E.P. § 2144(A) (emphasis added). It is respectfully submitted that this is not one of those “*rare*” circumstances when Official Notice may be used or at least, the Office Action Made Final does not state a reason why the present application must be classified as a “*rare*” circumstance as understood in the M.P.E.P. when Official Notice may be used.

Accordingly, Applicant respectfully submits that it is improper under normal Final Rejection practice under M.P.E.P. § 2144(A) for the Office Action Made Final (i.e., the application under Final Rejection) to have relied on Official Notice or to have made conclusory assertions, without documentary evidence, of what is allegedly well known.

Therefore, for at least the above reasons, Applicant respectfully requests that a subsequent Office Action be issued in which the subsequent Office Action does not rely upon Official Notice in attempting to present a *prima facie* case of obviousness.

Applicant respectfully requests that the Examiner produce references in support of the Examiner’s contention or, if the Examiner is relying upon personal knowledge to support the finding of what is known in the art, then the Examiner must provide an affidavit or declaration setting forth specific factual statements and explanations to support the finding. See, e.g., M.P.E.P. § 2144.03(C) and 37 C.F.R. § 1.104(d)(2). In any event, Applicant respectfully requests that the Examiner frame the *prima facie* case of obviousness in terms of the modification of cited documents in view of the newly cited documents, if applicable.

Applicant respectfully challenges the taking of Official Notice and/or the conclusory assertions of what is allegedly well known, without providing any supporting documentary evidence, as being improper under because the Office Action impermissibly makes naked assertions of *technical facts in the areas of esoteric technology*.

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M.P.E.P. § 2144.03(A) states that “assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art”.

The Office Action Made Final makes naked assertions of technical facts in an esoteric technology. The claimed inventions are considered esoteric technologies because one or more of the claimed inventions relate to one or more of the following: recording modes, data frames exchanged between a mobile set and a second device during a phone call; downlink voice signal; uplink voice signal; downlink video signal; uplink video signal; time stamping frames; data stream; uplink data frames; downlink data frames; voice activity; data structures; etc.

In view of the finding that the claimed inventions relate to esoteric technologies, the Office Action Made Final impermissibly makes naked assertions of technical facts.

For example, on page 6 of the Office Action Made Final, technical facts are asserted, without any supporting documentary evidence, that time stamping frames as set forth in claims 13, 15 and 17.

Such assertions of technical facts are improper with respect to esoteric technologies.

The M.P.E.P. cautions that “assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art **must always be supported by citation to some reference work recognized as standard in the pertinent art**”. See M.P.E.P. § 2144.03(A) (emphasis added).

The attention of the Examiner is respectfully drawn to the fact that the citation to some “reference work” must be “recognized as standard in the pertinent art”.

Thus, it is respectfully requested that if the Examiner attempts to support the undocumented assertions, the Examiner must use a “reference work” that is “recognized as standard in the pertinent art”.

Applicant respectfully requests that the Examiner issue a subsequent Office Action that provides citations to reference works that are recognized as standards in the pertinent art if the Examiner wishes to maintain the rejection under 35 U.S.C. § 103(a).

In addition, such assertions of technical facts are improper when brought up for the first time in a Final Rejection as set forth in M.P.E.P. § 2144(A).

It is respectfully requested that another Office Action, if necessary, be mailed in which Office Notice is not taken and in which technical facts are not asserted without any supporting documentary evidence.

It would be inappropriate to present, for the first time, documents in support of the impermissible taking of Official Notice in a Final Rejection, in an Advisory Action. Such action by the Examiner would leave Applicant with no recourse for reconsideration, which is undoubtedly the reasons why Official Notice in a Final Rejection is impermissible under M.P.E.P. § 2144(A).

In addition, Applicant respectfully submits that the Examiner is impermissibly considering particular elements *in a vacuum*. The particular elements should no be considered in a vacuum. Instead, the particular elements should be considered *in the context* of not only the other elements as set forth in claims 13, 15 and 17, but also in the context of the elements as set forth in independent claims and any intervening claims from which claims 13, 15 and 17 depend. *In the context* of the other elements as set forth in claims 13, 15 and 17 and also *in the context* of the elements as set forth in independent claims and any intervening claims from which claims 13, 15 and 17 depend, time stamping of frames as set forth in claims 13, 15 and 17 are not well known or obvious and certainly are not worthy of taking Official Notice.

Applicant respectfully submits that such assertions of technical facts are “not capable of instant and unquestionable demonstration as being well-known”. See M.P.E.P. § 2144.03(A).

It is respectfully submitted that it is believed that the Examiner might be improperly relying upon *present day* information and knowledge instead of properly considering information and knowledge as of the time of the effective filing date of the present application.

For at least the above reasons, it is respectfully requested that the Examiner mail another Office Action, if necessary, in which the Examiner does not take Official Notice, especially, if the Office Action is made Final.

Applicant respectfully requests that the Examiner produce references in support of the Examiner's contention or, if the Examiner is relying upon personal knowledge to support the finding of what is known in the art, then the Examiner must provide an affidavit or declaration setting forth specific factual statements and explanations to support the finding. See, e.g., M.P.E.P. § 2144.03(C) and 37 C.F.R. § 1.104(d)(2). In any event, Applicant respectfully

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requests that the Examiner frame the *prima facie* case of obviousness in terms of the modification of cited documents in view of the newly cited documents, if applicable.

Applicant does not necessarily agree or disagree with the Examiner's characterization of the documents made of record, either alone or in combination, or the Examiner's characterization of recited claim elements. Furthermore, Applicant respectfully reserves the right to argue the characterization of the documents of record, either alone or in combination, to argue what is allegedly well known, allegedly obvious or allegedly disclosed, or the characterization of the recited claim elements should that need arise in the future.

With respect to the present application, Applicant hereby rescinds any disclaimer of claim scope made in the parent application or any predecessor or related application. The Examiner is advised that any previous disclaimer of claim scope, if any, and the alleged prior art that it was made to allegedly avoid, may need to be revisited. Nor should a disclaimer of claim scope, if any, in the present application be read back into any predecessor or related application.

In view of at least the foregoing, it is respectfully submitted that the present application is in condition for allowance. Should anything remain in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the below-listed telephone number.

The Commissioner is hereby authorized to charge any additional fees, to charge any fee deficiencies or to credit any overpayments to the deposit account of McAndrews, Held & Malloy, Account No. 13-0017.

Dated: February 19, 2009

Respectfully submitted,

/Michael T. Cruz/

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